## REMARKS

## 35 USC §103

Claims 1, 10-12, 14-18, 27-29 and 31-32 are rejected under 35 USC §103(a) as being unpatentable over Allman (US 5100503) in view of Hussein et al (US 6365529). The Applicant disagrees, especially in view of the amendments presented earlier in the prosecution.

Claim 1 recites:

"A sacrificial coating material comprising:

at least one inorganic compound, and

at least one material modification agent, wherein the sacrificial coating material is transparent from a wavelength of 193nm to about 365nm and dissolvable in an alkaline-based chemistry or a fluorine-based chemistry." (emphasis added)

Claim 18 recites:

"A method of producing a sacrificial coating material, comprising:

providing at least one inorganic compound,

providing at least one material modification agent,

combining the at least one inorganic compound with the at least one material modification agent to form the sacrificial coating material, wherein the sacrificial coating material is transparent from a wavelength of 193nm to about 365nm and dissolvable in an alkaline-based chemistry or a fluorine-based chemistry." (emphasis added)

The Examiner states on page 3 of the Final Office Action: "Allman discloses the sacrificial coating material and method substantially as claimed." This point is just not supported by the Allman reference. The Allman reference – in the abstract and throughout the disclosure – states and recites that the coating material is a dyed coating material. There is nothing in this reference that would motivate one of ordinary skill in the art to consider producing a transparent sacrificial coating material from 193nm to about 365nm, because there is nothing in Allman that directs one of ordinary skill in the art in that direction or suggests that a transparent material would be beneficial. Then, the question is whether the Hussein reference fills in the obvious deficiencies of Allman.

The Hussein reference does not cure this obvious defect in Allman, even after reviewing Column 6, lines 18-41, as the Examiner suggests. Hussein actually teaches against using transparent materials in Column 6, lines 18-24 by suggesting that they "adversely affect the ability to control CDs and their uniformity." The Examiner believes that by merely disclosing that using transparent materials isn't wise that Hussein isn't teaching against transparent materials – but that just isn't sound logic. If Hussein is telling one of ordinary skill that the use of transparent materials isn't desirable or wise, then one of ordinary skill in the art isn't going to read Hussein and consider making transparent sacrificial materials. It just won't happen. *The Examiner must show some motivation from Hussein that would necessitate mentioning the undesirability of transparent materials and then do a 180 degree turn and recommend making transparent sacrificial materials.* That logical leap isn't made by Hussein – and therefore, it is not a relevant reference for the current claims.

Hussein then goes on to disclose dyed materials and their use. Therefore, one of ordinary skill in the art of sacrificial materials would not read Allman and Hussein and consider them to be motivating references to form the claims provided in the current application.

The Federal Circuit in *In re Rudko* (Civ. App. No. 98-1505 (Fed Cir. May 14, 1999)) determined that an invention was held not obvious where one prior art reference taught away from the combination with a second prior art reference. There must be a motivation to

combine the references by reviewing each of them and determining if it is desirable to one of ordinary skill to combine the disclosures. (please see *Winner International Royalty Corp. v Wang*, 202 F.3d 1340) However, when one reference actually teaches away from an embodiment – then it is obvious that there can be no motivation to combine.

Given that the present application is patentable over Allman, the present application is also patentable over Hussein, since Hussein not only does not teach to, suggest to or motivate one of ordinary skill in the art to produce transparent sacrificial materials comprising the components in claims 1 and using the methods of claim 18, but in fact teaches away from producing transparent sacrificial materials comprising the components in claims 1 and using the methods of claim 18. Claims 1 and 18 are therefore allowable as being patentable over Allman in view of Hussein. In addition, claims 10-12, 14-17, 27-29 and 31-32 are allowable as being patentable over Allman in view of Hussein by virtue of their dependency on claims 1 and 18, respectively.

Claims 1-13 and 18-29 are rejected under 35 USC §103(a) as being unpatentable over Kennedy et al. (US 6506497) in view of Hussein et al (US 6365529). The Applicant disagrees, especially in view of the amendments presented earlier in the prosecution.

Claim 1 recites:

"A sacrificial coating material comprising:

at least one inorganic compound, and

at least one material modification agent, wherein the sacrificial coating material is transparent from a wavelength of 193nm to about 365nm and dissolvable in an alkaline-based chemistry or a fluorine-based chemistry." (emphasis added)

Claim 18 recites:

"A method of producing a sacrificial coating material, comprising:

providing at least one inorganic compound,

providing at least one material modification agent,

combining the at least one inorganic compound with the at least one material modification agent to form the sacrificial coating material, wherein the sacrificial coating material is transparent from a wavelength of 193nm to about 365nm and dissolvable in an alkaline-based chemistry or a fluorine-based chemistry." (emphasis added)

The Examiner states on page 5 of the Final Office Action: "Kennedy discloses the sacrificial coating material and method substantially as claimed." This point is just not supported by the Kennedy reference. The Kennedy reference – in the abstract and

throughout the disclosure – states and recites that the coating material is a dyed coating material. In addition, the Kennedy reference states that their contemplated compounds strongly absorb from at least 193nm to 365nm. There is nothing in this reference that would motivate one of ordinary skill in the art to consider producing a transparent sacrificial coating material, because there is nothing in Kennedy that directs one of ordinary skill in the art in that direction or suggests that a transparent material would be beneficial. Then, the question is whether the Hussein reference fills in the obvious deficiencies of Kennedy.

The Hussein reference does not cure this obvious defect in Kennedy, even after reviewing Column 6, lines 18-41, as the Examiner suggests. Hussein actually teaches against using transparent materials in Column 6, lines 18-24 by suggesting that they "adversely affect the ability to control CDs and their uniformity." The Examiner believes that by merely disclosing that using transparent materials isn't wise that Hussein isn't teaching against transparent materials – but that just isn't sound logic. If Hussein is telling one of ordinary skill that the use of transparent materials isn't desirable or wise, then one of ordinary skill in the art isn't going to read Hussein and consider making transparent sacrificial materials. It just won't happen. *The Examiner must show some motivation from Hussein that would necessitate mentioning the undesirability of transparent materials and then do a 180 degree turn and recommend making transparent sacrificial materials.* That logical leap isn't made by Hussein – and therefore, it is not a relevant reference for the current claims.

Hussein then goes on to disclose dyed materials and their use. Therefore, one of ordinary skill in the art of sacrificial materials would not read Kennedy and Hussein and consider them to be motivating references to form the claims provided in the current application.

The Federal Circuit in *In re Rudko* (Civ. App. No. 98-1505 (Fed Cir. May 14, 1999)) determined that an invention was held not obvious where one prior art reference taught away from the combination with a second prior art reference. There must be a motivation to combine the references by reviewing each of them and determining if it is <u>desirable</u> to one of ordinary skill to combine the disclosures. (please see *Winner International Royalty Corp. v*

*Wang*, 202 F.3d 1340) However, when one reference actually teaches away from an embodiment – then it is obvious that there can be no motivation to combine.

Given that the present application is patentable over Kennedy, the present application is also patentable over Hussein, since Hussein not only does not teach to, suggest to or motivate one of ordinary skill in the art to produce transparent sacrificial materials comprising the components in claims 1 and using the methods of claim 18, but in fact teaches away from producing transparent sacrificial materials comprising the components in claims 1 and using the methods of claim 18. Claims 1 and 18 are therefore allowable as being patentable over Kennedy in view of Hussein. In addition, claims 10-12, 14-17, 27-29 and 31-32 are allowable as being patentable over Kennedy in view of Hussein by virtue of their dependency on claims 1 and 18, respectively.

## REQUEST FOR AN INTERVIEW

The USPTO Director has stated that Examiners and Applicants should work together through the interview process to move cases forward. To that end, a Request for Interview form is hereby submitted in order to address any outstanding issues in this case and resolve this matter, so that it can proceed to allowance.

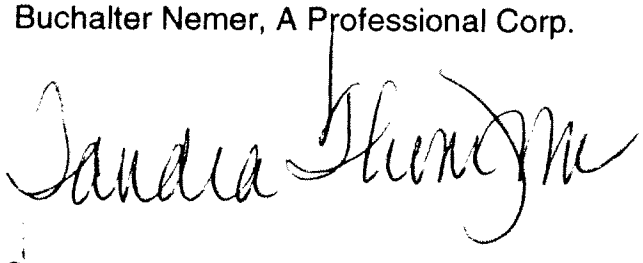
## REQUEST FOR ALLOWANCE

Claims 1-32 are pending in this application and the Applicant respectfully requests that the Examiner reconsider the claims in light of the arguments presented and allow all pending claims.

Respectfully submitted,

Buchalter Nemer, A Professional Corp.

Dated: July 19, 2010

By: 

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